

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

App. No. : 10/708,224
Applicant : Masuhiro Natsuhara
Filed : February 18, 2004
T.C./A.U. : 3742
Examiner : Sang Yeop Paik
Docket No. : 39.033
Customer No. : 29453

Honorable Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

For the reasons stated below, Applicants have requested a panel review of the legal and factual basis of the rejections, made final, in the Office action of March 8, 2006 in the above-identified patent application.

ARGUMENTS

Accompanying Pre-Appeal Brief Request for Review

1. The lone rejection of the pending claims in this case, claims 1 through 4, is under 35 U.S.C. § 103 over a single reference, U.S. Pat. No. 6,071,465 to Kobayashi, presumably in combination with knowledge of those skilled in the wafer holder arts. Applicants submit that the examiner's *prima facie* case in support of this rejection, now repeated verbatim and made final, is deficient for at least two reasons: lack in the factual basis; and error in the reasoning.
2. The examiner has not presented factual evidence that aligning "the center of the supporting shaft (. . .) with the center of the substrate"—as the examiner alleges is shown in the figures of Kobayashi—leads to a device that *completely* meets the limitations of claim 1 of the present application. Specifically, the examiner has not pointed to any showing in Kobayashi that distance between the axial center of the wafer-carrying side of the "disk-shaped base 37" of the heating apparatus illustrated in Fig. 10 (the only relevant figure) of Kobayashi, and the axial center

of the "tube-shaped body 35" is 5% or less of the diameter of the wafer-carrying side.

3. Granting that the motivation that the Office gives to combine references, or a lone reference with a skilled artisan's knowledge, need not match the motivation that inspired the inventors, the examiner has failed to demonstrate that the motivation he mentions would in fact lead to a combination that meets each and every limitation of Applicants' claim 1—and most specifically, the limitation just quoted. The examiner has merely made a general statement that Kobayashi shows "that the center of the supporting shaft is aligned with the center of the substrate" and that a person skilled in the art would have been motivated to have the alignment be "within the claimed range to prevent imbalancing of the substrate on the supporting shaft." **But the examiner has failed to demonstrate how the Kobayashi device, thus modified "to prevent imbalancing" would meet Applicants' claim 1 limitation with regard to the wafer-carrying side of a wafer holder.**
4. Furthermore, under Response to Arguments in the final Office action, the examiner states

Kobayashi[,] realizing the importance of having . . . proper machined surfaces and the flatness of the device that is in a micro scale[,] would have been further motivated to achieve a stable balance of the substrate with respect to the shaft to ensure a desired heating distribution along the heating surface.
5. Notwithstanding the above-quoted comment by the examiner, Applicants submit that the examiner is applying hindsight reasoning, and that consequently the examiner has not made a proper *prima facie* case of the obviousness of claim 1 over the Kobayashi reference (in combination with the common knowledge of those skilled in the art).
6. That is, in addressing the surface limitations recited in claim 1 of the present invention, the examiner uses hindsight reasoning in making his statements about Kobayashi "realizing the importance of having . . . proper machined surfaces and the flatness" in the relevant components of his device, and being "motivated to achieve a stable balance of the substrate with respect to the shaft to ensure a desired heating distribution along the heating surface."
7. Therefore, Applicants submit that such hindsight reasoning constitutes a factual deficiency in the examiner's rejections.

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Remarks
Pre-Appeal Request for Review dated September 8, 2006

It is believed that the present paper, as attached to form PTO/SB/33, "Pre-Appeal Brief Request for Review," constitutes a properly filed request for panel review. Accordingly, Applicants earnestly solicit a panel decision based on the panel's review of Applicants' remarks and the examiner's rejections.

Respectfully submitted,

September 8, 2006

/James Judge/

James W. Judge
Registration No. 42,701

JUDGE & MURAKAMI IP ASSOCIATES
Dojima Building, 7th Floor
6-8 Nishitemma 2-Chome, Kita-ku
Osaka-shi 530-0047
JAPAN

Telephone: **305-938-7119**
Voicemail/Fax: **703-997-4565**